

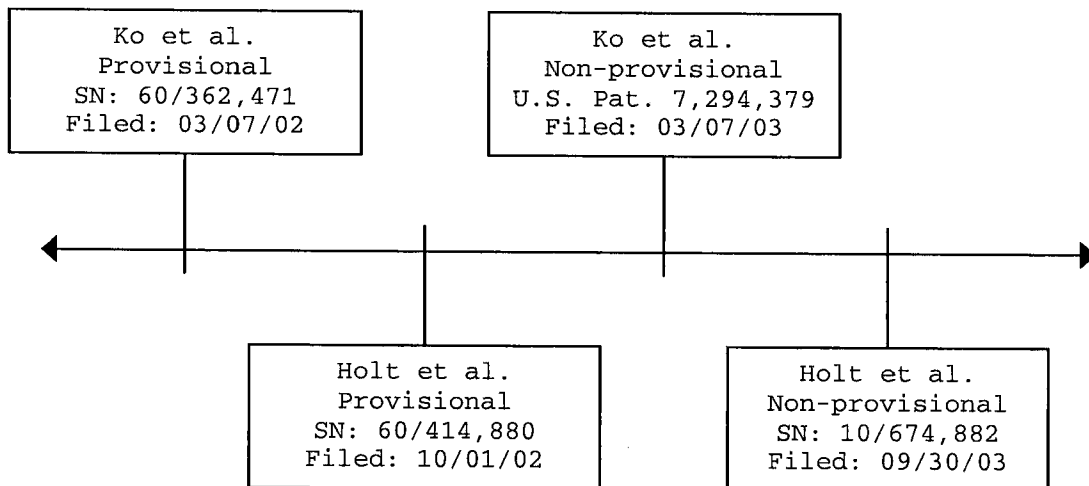
REMARKS

Claims 1-11 are pending in the current application. Claims 5-7 were withdrawn from consideration. In the non-final Office action, the Office rejected the remaining claims 1-4 and 8-11 under 35 U.S.C. § 102(e).

35 U.S.C. § 102 Rejections

The Office rejected claims 1-4 and 8-11 under 35 U.S.C. § 102(e) as being anticipated by Ko et al. (U.S. Pat. 7,294,379). In order to qualify as prior art, the Office relies on a priority claim in Ko et al. claiming priority to U.S. Provisional Patent Application No. 60/362,471 filed on March 7, 2002. However, as discussed below, U.S. Provisional Patent Application No. 60/362,471 fails to disclose the invention claimed in Applicant's present application.

Below please find a timeline indicating the dates of filing for the Ko et al. application and the present application (Holt et al.).



Importantly, in Applicant's present non-provisional application, the Applicant claims benefit to the provisional application (Serial No. 60/414,880 filed on October 1, 2002) in the related applications section of the specification.

A review of the Applicant's provisional application shows that the Applicant's provisional application enables and provides written description support for the inventions claims in claims 1-4 and 8-11 of the Applicant's present application. In particular, see pages 8 and 9 of the Applicant's provisional patent application under the sub-heading "SELF-EXPIRING INSPECTION STICKER" and FIGS. 9 and 10. This section describes a one-piece foldable construction having an activating adhesive and migrating ink. Notably, on page 9, the provisional application describes and shows a preferred embodiment in which the remaining exposed adhesive is used to attach the inspection sticker to an item. This prior application establishes the Applicant satisfies the enablement and written description requirements of 35 U.S.C. §112, first paragraph, and thus, the Applicant is entitled to the benefit of the October 1, 2002 filing date.

It is noted that although Ko et al. non-provisional patent application claims priority to the Ko et al. provisional patent application filed on March 7, 2002, that the Ko et al. provisional patent application fails to disclose the subject matter claimed in the Applicant's present application. In particular, the portion of the specification and figures in the Ko et al non-provisional patent application relied upon by the Office in the rejection under 35 U.S.C. § 102(e) are not found in the Ko et al. provisional application.

The Ko et al. provisional application fails to disclose all of the elements of the claimed invention. Among other things, Ko et al. does not show a substrate having two portions with an

upper surface, with one of the portions of the upper surface having an adhesive such that, when folded, a portion of the adhesive remains exposed, as required in independent claims 1 and 8 of Applicant's present application. Accordingly, the subject matter disclosed in the non-provisional patent application filed by Ko et al. on March 7, 2003 and claimed in Applicant's present application is not entitled to the filing date of the provisional patent application filed by Ko et al. on March 7, 2002.

As discussed above, the subject matter claimed in Applicant's present application is not disclosed in the provisional patent application filed by Ko et al. on March 7, 2002. Moreover, the Applicant's present application claims priority to U.S. Provisional Patent Application No. 60/414,880 filed on October 1, 2002, which predates the Ko et al. non-provisional patent application (U.S. Pat. 7,294,379) filed on March 7, 2003. Therefore, the Applicant respectfully asserts that the Applicant invented the subject matter claimed in the Applicant's present application prior to Ko et al. filing an application for patent describing the subject matter claimed in the Applicant's present application. Accordingly, the Applicant respectfully requests the withdrawal of the rejection of claims 1-4 and 8-11 based on 35 U.S.C. § 102(e) for being anticipated by Ko et al.

Other Remarks

The Applicant respectfully notes that only claims 5-7 were withdrawn during the Applicant's election to the restriction requirement. Although this is correctly reflected in the Office action Summary, paragraph 2 of the Office action incorrectly states that claims 5-10 have been withdrawn.

Conclusion

In view of the remarks above, it is believed that the application is in condition for allowance. However, the Examiner is invited to contact the undersigned attorney by telephone if doing so would expedite the allowance of this application.

No additional fees are believed to be due for this response. However, in the event that other fees are due, including fees for an extension of time, please charge them to Deposit Account 17-0055.

Respectfully submitted,

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